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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,705	03/05/2002	Peter Michalos	J504-005 US	4788
21706 7590 07/14/2008 NOTARO AND MICHALOS 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100				
EXAMINER				
GILBERT, ANDREW M				
ART UNIT		PAPER NUMBER		
3767				
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07/14/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/090,705

**Applicant(s)**

MICHALOS ET AL.

**Examiner**

ANDREW M. GILBERT

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 April 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6, 8 and 10-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 6, 8 and 10-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgments***

1. This office action is in response to the reply filed on 4/25/2008 in response to the previous office action done by a previous examiner on 12/27/2007.
2. In the reply, the applicant cancelled claims 1-5, 7, 9 and added new claims 12-13.
3. Thus, claims 6, 8, 10-13 are pending for examination.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6, 10, 11, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makino (6878165) in view of Webster et al (5503320). Makino discloses in a probe set and tool for use in canaliculus intubation of a lacrimal duct, the probe set having a probe for passing from a nasolacrimal duct to a nasal inferior meatus, the probe having an enlarged end portion, and a tool to draw the probe from the lacrimal duct (Figs 1-18 and disclosure). Furthermore, Makino discloses the importance of providing a determination of the location of the distal ends of the probe and tool during use (Background, Disclosure) and discloses using light emitting devices to illuminate the distal ends of the probe and tools to help the practitioner determine their respective locations during use.

6. However, Makino does not expressly disclose the improvement comprising a circuit which is normally open and which includes a signaling mechanism and power source for powering the signaling mechanism to generate at least one of an audible and a visual signal that can be perceived by a practitioner when the circuit is closed. the circuit comprising a pair of wires connected to the signaling mechanism; and means for directly mechanically and electrically attaching and connecting the pair of wires respectively to conductive portions of the probe and the tool for directly mechanically and electrically connecting the conductive portions of the probe and tool to the circuit, the circuit being closed only when the tool directly touches the probe to mechanically and electrically connect the probe to the tool to generate the signal to indicate to the practitioner that the tool has touched the probe.

7. Webster et al teaches that it is known to have a circuit which is normally open (summary) and which includes a signaling mechanism and power source for powering the signaling mechanism to generate at least one of an audible and a visual signal that can be perceived by a practitioner when the circuit is closed (Abstract, Summary, col 4, lns 10-39; col 5, lns 9-18; col 54-57; col 8, lns 10-15); the circuit comprising a pair of wires (106, 107) connected to the signaling mechanism (col 4, lns 10-32); and means for directly mechanically and electrically attaching and connecting the pair of wires respectively to conductive portions of the probe and the tool (108, 109) for directly mechanically and electrically connecting the conductive portions of the probe and tool to the circuit, the circuit being closed only when the tool directly touches the probe to mechanically and electrically connect the probe to the tool to generate the signal to

indicate to the practitioner that the tool has touched the probe (Abstract, Summary, col 4, lns 10-39; col 5, lns 9-18; col 54-57; col 8, lns 10-15) for the purpose of indicating to the surgeon in an easily perceivable manner that the appropriate location of the two surgical elements has been achieved (col 1, lns 56-64; col 5, lns 14-18; col 8, lns 12-15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device as taught by Makino with the circuit and signaling mechanism as taught by Webster et al for the purpose of indicating to the surgeon in an easily perceivable manner that the appropriate location (ie in the instant case, connection) of the probe and tool has been achieved.

8. Claims 8, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makino in view of Webster et al in further view of Fortino (4005362). Makino and Webster et al disclose the invention substantially as claimed except for expressly disclosing that the attaching means are a pair of clips for respectively connecting the wires to the probe and tool. Fortino teaches that it is known to have clips (60) for the purpose of selected establishment of circuit connection to respective probes in question for determination of viability of circuit continuity. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the electrical connections as taught by Makino and Webster et al with the clips as taught by Fortino for the purpose of selective establishment of circuit connection to respective probes in question for determination of viability of circuit continuity.

***Response to Arguments***

9. Applicant's arguments with respect to claims 6, 8, 10-13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **ANDREW M. GILBERT** whose telephone number is (571)272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew M Gilbert/  
Examiner, Art Unit 3767  
/Kevin C. Simons/  
Supervisory Patent Examiner, Art Unit 3767